

Remarks

Restriction Requirement

In the Action mailed October 17, 2006, the Office restricted the application to the following Groups of claims:

Group I - Claims 1-15, 35 and 36, drawn to a method of increasing the isoflavone aglycone concentration in a soy-containing comestible, classified in Class 426, subclass 634;

Group II - Claims 16-29, drawn to a comestible subcombination, classified in Class 426, subclass 634; and

Group III - Claims 30-34, drawn to a soy bread product, classified in Class 426, subclass 634.

Election and Traverse

In response to the Restriction Requirement, Applicant elects Group II, i.e. claims 16-29, **with traverse.**

The Office makes the case that the inventions are distinct, because of the following reasons:

Inventions I and II/III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case, the product can be made by a process wherein isoflavone aglycone obtained from a different source is directly added to the subject soy material. (Office Action, page 2, lines 12-18.)

Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a comestible having a beta-glucosidase activity as called for in the subcombination (e.g. claim 16). The

subcombination has separate utility such as use in a soy drink or soy cheese. (Office Action, pages 2-3, lines 19-6.)

(Office Action, Page 3.) Here the Office concludes that because these inventions are independent or distinct and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (M.P.E.P. § 808.02), restriction for examination purposes as indicated is proper.

Applicants submit that restriction is not proper in this instance. M.P.E.P. § 803 states the requirement for a *proper* restriction.

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; and (B) There must be a *serious* burden on the examiner if restriction is required. (M.P.E.P. § 803, citations omitted, emphasis added.)

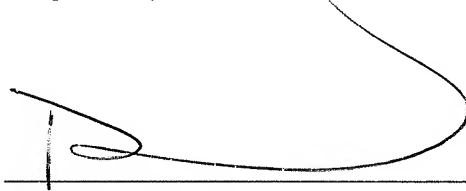
Thus, there are two requirements for restriction: distinctness and a *serious* burden. Both are required; distinctness without a serious burden is not sufficient to justify restriction. Indeed, section 803 explicitly states that “[i]f the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” (Emphasis added.)

Applicants respectfully submit that restriction is not proper in this case because the burden would not be serious. While the claims of Groups I, II and III may satisfy the Office’s requirements for distinctness, their consideration would not appear to result in a serious burden on the Office. A method of increasing the isoflavone aglycone concentration in a soy containing comestible, and a comestible of Group II and a soy bread product of Group III may be distinct, but a cursory Delphion search of class 426, subclass 634 resulted in a total of 622 references. Narrowing the search to “soy” resulted in 176 references, and further narrowing to search to include “isoflavone” resulted in only 25 preliminary references. Clearly the field of search could

be even more concise and yield even fewer references. Applicants respectfully submit that consideration of the claims of Group I, II and III together would not result in a serious burden on the Office. Thus, Applicants respectfully request that the Office reconsider the Restriction Requirement, and consider Groups I, II and III together.

It is believed that there is no fee or no additional fee associated with the filing and consideration of this document, however, should the Commissioner decide that any fee or fee deficiency is due, the Commissioner is hereby authorized to charge any and all fees incurred as a result of entering or considering this document to deposit account number 03-0172.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Diane H. Dobrea', is written over a horizontal line.

Date: December 15, 2006

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